

## **REMARKS**

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner objects to the disclosure because the status of the parent application in the first paragraph needs to be updated. In response, the first paragraph of the specification has been amended to reflect that U.S. Application No. 09/931,847, filed on August 17, 2001, is now U.S. Patent No. 6,736,772 issued on May 18, 2004. Accordingly, it is respectfully requested that the objection to the disclosure be withdrawn.

In the Official Action, the Examiner rejects claims 1-6 and 16 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,547,721 to Higuma et al., (hereinafter “Higuma”). Furthermore, the Examiner rejects claims 1-5, 16 and 17 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,608,270 to Donofrio et al., (hereinafter “Donofrio”). Lastly, the Examiner rejects claims 1-5, 16 and 17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,658,238 to Suzuki et al., (hereinafter “Suzuki”) in view of U.S. Patent No. 4,021,630 to Taylor (hereinafter “Taylor”).

In response, Applicants respectfully traverse the Examiner’s rejections under 35 U.S.C. §§ 102(e) and 103(a) for at least the reasons set forth below. However, independent claim 2 has been canceled (along with dependent claim 3) and independent claim 1 has been amended to clarify its distinguishing features. Claims 4-6 and 16 have also been amended to change their dependencies from canceled claim 2 to independent claim 1 and/or to be consistent with amended claim 1. The amendment to claim 1 is fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the amendment to claim 1.

Specifically, independent claim 1 has been amended to clarify that a gap is provided between the switch and the presser, the gap being set so as to be maintained even in a

state in which the pressing member is loaded by pressurizing due to autoclaving. The amendment to claim 1 is fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the amendment to claim 1.

In the water-proof switch mechanism of the endoscope suitable for autoclaving of claim 1, when pressurizing for autoclaving, a gap is provided between the switch and the presser so that the presser does not come in contact with the switch. In other words, the gap between the switch and the presser is set larger than the displacement amount of the presser that is deformed when pressurizing for autoclaving.

In contrast, the Higuma reference discloses an apparatus for autoclaving in which a gap is provided between the switch and the presser. However, the Higuma reference does not disclose or contemplate preventing the switch from coming in contact with the presser when pressurizing for autoclaving. Thus, Higuma does not disclose or suggest any means for prevent such contacting at the time of pressurizing. The other cited references also do not disclose such features.

With regard to the rejections of claims 1-6, 16 and 17 under 35 U.S.C. § 102(e), an endoscope having the features discussed above and as recited in independent claim 1, is nowhere disclosed in either Higuma or Donofrio. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”<sup>1</sup> independent claim 1 is not anticipated by either Higuma or Donofrio. Accordingly, independent claim 1 patentably distinguishes over both Higuma and Donofrio and is allowable. Claims 4-6, 16 and 17, being dependent upon claim 1, are thus at least allowable therewith (claims 2 and 3 being canceled). Consequently, the

---

<sup>1</sup> Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

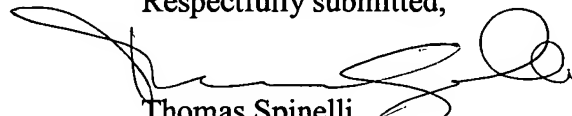
Examiner is respectfully requested to withdraw the rejections of claims 1-6, 16 and 17 under 35 U.S.C. § 102(e).

With regard to the rejection of claims 1-5, 16 and 17 under 35 U.S.C. § 103(a), independent claim 1 is not rendered obvious by the cited references because neither the Suzuki patent the Taylor patent, whether taken alone or in combination, teach or suggest an endoscope having the features discussed above. Accordingly, claim 1 patentably distinguishes over the prior art and is allowable. Claims 4, 5, 16 and 17, being dependent upon claim 1, are thus allowable therewith (claims 2 and 3 being canceled). Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-5, 16 and 17 under 35 U.S.C. § 103(a).

Lastly, with regard to Donofrio, the Applicant respectfully requests that the Examiner withdraw the Donofrio reference because the priority date of the present application (August 28, 2000) is earlier than the effective filing date of Donofrio (October 20, 2000). Thus, Donofrio is not a proper reference to be applied against the claims of the present application.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



Thomas Spinelli  
Registration No. 39,533

Scully, Scott, Murphy & Presser, P.C  
400 Garden City Plaza, Suite 300  
Garden City, New York 11530  
(516) 742-4343  
TS:cm